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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,920	01/10/2006	Anthony Haynes	608-474	5439

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EXAMINER	
TAKEUCHI, YOSHITOSHI	
ART UNIT	PAPER NUMBER
1793	

MAIL DATE	DELIVERY MODE
06/22/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/563,920	**Applicant(s)** HAYNES ET AL.	
	Examiner YOSHITOSHI TAKEUCHI	**Art Unit** 1793	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 May 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires *3* months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See Continuation Sheet*. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *25-44 and 46-50*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Roy King/
Supervisory Patent Examiner, Art Unit 1793

/YOSHITOSHI TAKEUCHI/
Examiner, Art Unit 1793

Continuation of 3. NOTE: The proposed amendment to independent claim 25, from which claims 26-50 depend, changing the scope of the claims from "at least one non-halohalogenoic acid promoter" being optional to being required was not present in the finally rejected claims and would require further consideration based on the change in scope.

Continuation of 11. does NOT place the application in condition for allowance because:

The Applicant filed four arguments on May 4, 2009, which have been fully considered but they are not persuasive for the following reasons.

First, regarding the 35 U.S.C. § 103(a) rejections of claims 25-31, 43-44, and 46-50, the applicant argues Baker does not teach using non-hydrohalogenoic acids as iridium catalyst promoters. (Response to the Office action, p.8).

In response, the Office agrees that Baker alone does not explicitly teach the use of non-hydrohalogenoic acids as iridium catalyst promoters. However, as noted in the prior Office action, Baker in view of Bruner renders the present invention obvious and it would have been obvious to a person of ordinary skil in the art to use the promoter of Bruner in the Baker system because the two catalytic systems are similar.

Second, the applicant argues the "Bruner process is clearly completely different to the process of the present invention" (Id at 9) and is "not analogous (Id at 120, emphasis in the original).

In response, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347 (Fed. Cir. 1992). In this case, while the particular mechanisms of the two references are different from each other, the problem to be solved is to insert a carbonyl group using a transition metal in order to produce acetic acid. Acetic acid is an important industrial chemical, where low costs of production are paramount. As a result, it would have been obvious to try inserting a carbonyl group using the iridium catalyst, carbon monoxide and a promoter, which has been successfully used to catalyze the formation of adipic acid.

Third, the applicant argues Pesa relates to a "different technical field to that of the present invention." (Response to Office action pp.10-11).

In response, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See In re Oetiker, 977 F.2d 1443 (Fed. Cir. 1992). In this case, Pesa is used merely to show that it was well known in the art at the time of the invention that HBF4 is equivalent to phosphoric acid for purposes of promoting a reaction.

Fourth, the applicant argues that Wegman teaches away from the use of methyl iodide (response to Office action p.11) because "Wegman states that the use of halide promoters is undesirable since they are highly corrosive (Id)."

In response, while Wegman states the use of halide promoters is undesirable, a known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use. MPEP 2123 II. A patent may be used for all that it contains and is "not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." In re Heck, 699 F.2d 1331, 1332-33 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009 (CCPA 1968)). See also MPEP § 2123(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YOSHITOSHI TAKEUCHI whose telephone number is (571) 270-5828. The examiner can normally be reached on Monday-Thursday 9:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/YOSHITOSHI TAKEUCHI/
Examiner, Art Unit 1793